UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,773	09/22/2003	Andreas Birkenfeld	4100-323	3309

27799 7590 08/13/2008

COHEN, PONTANI, LIEBERMAN & PAVANE LLP
551 FIFTH AVENUE
SUITE 1210
NEW YORK, NY 10176

EXAMINER	
ALIE, GHASSEM	
ART UNIT	PAPER NUMBER
3724	
MAIL DATE	DELIVERY MODE
08/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/668,773	BIRKENFELD ET AL.	
	Examiner	Art Unit	
	GHASSEM ALIE	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meschi (5,720,223) in view of Faltin (3,889,939), and in further view of Hashigaya (2002/0088323). Meschi discloses a method of cross-cutting a web (1) having a repeated sequence of at least two printed pages with different heights (la, lb, lc, ld) substantially as claimed, including: printing (printing heads 2, 3) a web (1) with the repeated sequence of at least two printed pages with different heights; moving the printed web (1) in a running direction so that the printed web is supplied at an approximately constant web speed to a cross-cutting device (12) comprising a cutting cylinder (13) having at least one cutting knife (16) and being driven by a cutting cylinder motor (15) to rotate about an axis parallel to a cross-cutting line, the cutting cylinder motor being controlled by a computer and storage unit (24); cutting the printed web transversely to said running direction successively to form different sheets corresponding to at least two printed pages with different heights (la, lb, lc, ld). Meschi fails to expressly disclose the printing mechanism is a printing press having a plate cylinder, or that the sequence of pages is printed for each rotation of the plate cylinder. However, Faltin discloses a method of cross-cutting a web (18) comprising a web-fed rotary printing press (10) having a plate cylinder (30, 32) driven by

a plate cylinder motor, wherein the repeated sequence of pages is printed for each rotation of the plate cylinder. This arrangement provides smooth operation of the device by synchronizing the movement of the printing press and the cross-cutting device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print a sequence of pages for each rotation of the plate cylinder in order to provide smooth operation of the device through synchronization of the printing press and the cross-cutting device.

To the extent it can be argued that Meschi does not disclose a repeated sequence of pages, the Meschi device is clearly capable of printing any sequence of pages, including the one disclosed by Applicant, based on the desires of the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the web of the Meschi method with a repeated sequence of at least two printed pages with different heights in order to create a sequence of pages desired by the user.

To the extend it can be argued that Meschi, as modified by Faltin, does not explicitly teach the step of communicating a rotary position if the plate cylinder from the plate cylinder motor to the computing and storage unit, Meschi teaches that encoder 26 is integral with the axis of the printing roller which is connected to the motor of the printing roller. See col. 4, lines 64-67. In this case, the motor of the printing roller communicates with the processor or the computing and storage unit. Therefore, the position of the printing roller (or the plate cylinder) also is communicated to the processor 24. In addition, the use of controller system to communicate position of a feeding roller by the feeding roller motor and the position of a

cutter to a memory and storage unit is well known in the art such as taught by Hashigaya. It would have been obvious to a person of ordinary skill in the art to control the speed of the plate cylinder or the printing roller and the cutting roller in Meschi's cutting apparatus, as modified by Faltin, by a controlling mechanism as taught by Hashigaya, in order to easily adjust the speed of the plate cylinder and the cutting roller with respect to each other. In this case, any sequence for the speed of the cylinder plate and corresponding instructions for the cutter could be selected from the memory of the controller in order to produce particular lengths of products or workpieces.

3. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meschi in view of Faltin and Hashigaya, as applied to claim 11, and in further view of Jumel et al. (4,620,466). The modified Meschi method fails to teach an unwind device. However Jumel et al disclose an unwind device (42) used in a cutting machine. The unwind device saves space in comparison to a rotary press. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an unwind device, as disclosed by Jumel et al, with the modified Meschi method for the purpose of saving floor space.

Response to Argument

4. Applicant's argument that Meschi discloses a data printer which includes features that are not readily combinable with a rotary press is not persuasive. Applicant's argument that the feed for the data printer of computer paper in Meschi does not operate at the speed of a web traveling through a rotary printer press of the instant invention is not persuasive. It should be noted that the speed of the feeder has not been claimed. Applicant's argument that

Meschi fails to disclose the step of printing the web with the repeated sequence of at least two printed pages with different heights in a web-fed rotary printing press having a plate cylinder driven by a plate cylinder motor is not persuasive. It should be noted this step is taught by Faltin. In other words, Meschi in combination with Faltin teaches a plate cylinder for printing at least two printed pages with different height in web-fed rotary printing press. It should be noted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that Faltin is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, using a plate cylinder in Faltin to print images with different heights on the printed pages in Meschi is another alternative way to print images on the printed pages.

Applicant's argument that Meschi, Faltin, and Hasigaya fail to disclose the step of "printing the web with the repeated sequences of at least two printed pages with different heights in a web-fed printing press" is not persuasive. Meschi device is clearly capable of printing any sequence of pages, including the one disclosed by Applicant, based on the desires of the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the web of the Meschi method with a repeated

sequence of at least two printed pages with different heights in order to create a sequence of pages desired by the user.

Conclusion

5. **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571 272-4502. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GA

/Ghassem Alie/

Primary Examiner, Art Unit 3724

July 29, 2008